

## **REMARKS**

This present Response is being filed in reply to the Office Action dated September 5, 2008. Applicant requests a two (2) month extension of time to extend the period of response to and including February 5, 2009.

By the present amendment, claims 37-47 are pending in the application.

### ***Request for Telephonic Interview***

Applicant requests a telephonic interview with the Examiner and the Examiner's supervisor prior to acting on the present Response. The purpose of the telephonic interview will be to discuss the pending claims and the references cited in the Office Action. Applicant requests that the Examiner contact the undersigned to schedule the telephonic interview.

### ***Rejection Pursuant to 35 U.S.C. § 103(a)***

The Office Action rejected claims 37-47 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Pagliuca (US Patent Application Publication 2003-0073998) in view of Chin (US Patent Application Publication 2005-0065517) and Koros (U.S. Patent No. 5,928,139). Applicant respectfully traverses this rejection based on the following arguments.

As noted in the Office Action, Pagliuca fails to disclose advancing a third anchor through a percutaneous incision, as recited in claim 37, and fails to disclose percutaneously positioning a third anchor through an incision distinct from a first incision receiving a first and second anchor, as recited in claim 47. Nor does Pagliuca disclose advancing a first end of a spinal rod subcutaneously to a third anchor, as recited in claims 37 and 47. The Office Action relies on Chin for teaching these and other steps of the rejected claims. However, the Office Action provides no rationale as to why it would have been obvious for one of ordinary skill in the art to combine the purported teachings of the two references. The Supreme Court quoting *In re Kahn*, (78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness.’’ *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396(2007).

The Office Action has fails to articulate reasoning with rational underpinnings to support the conclusion that it would have been obvious for one of ordinary skill in the art to combine the purported teachings of the two references.

The Office Action states only that it would have been obvious to combine the two references “to perform minimally invasive surgery.” This statement is woefully inadequate as basis for combining the purported teachings of the references to arrive at the claimed invention. It fails to explain why one of ordinary skill in the art would add the specific claimed features missing from Pagliuca but purportedly found in Chin, namely:

- advancing a third anchor through a percutaneous incision, as recited in claim 37,
- percutaneously positioning a third anchor through an incision distinct from a first incision receiving a first and second anchor, as recited in claim 47, and
- advancing a first end of a spinal rod subcutaneously to a third anchor, as recited in claims 37 and 47,

to the minimally invasive techniques described in Pagliuca. Pagliuca describes minimally invasive techniques for securing vertebra:

“While the above described apparatus enables many types of surgeries at small surgical sites, the fixing of vertebrae together has heretofore been conducted by a much more invasive open surgical method.” (Paragraph 6, Background of Pagliuca)

“Utilizing the cannula 10 and support apparatus 110 for placement of the fixation assembly 620 at the surgical site and attachment of the fixation assembly 620 to the vertebrae 601, 602 in a manner to be described results in a much less invasive procedure and significantly less blood loss.” (Paragraph 170, Description of a Preferred Embodiment)

“For example, certain features or instrumentation described herein are particularly useful for a minimally invasive, e.g., arthroscopic procedures, in which the expandable distal portion of the expandable conduit prevents the instrument from dislodging or popping out of the operative site.” (Paragraph 190, Description of a Preferred Embodiment)

As noted in the Office Action, Chin also describes minimal invasive surgical techniques. According to the Office Action, merely because Chin describes minimally invasive surgical techniques, the teachings of Chin may be added to the minimally invasive techniques described in Pagliuca without any further explanation. Under this reasoning, any two references in the field of minimally invasive surgery may be combined to render obvious a novel minimally invasive surgical technique simply because (1) the references teach minimally invasive surgical techniques and (2) the benefits of minimally invasive surgery, e.g., faster healing times, shorter hospital stays, less scarring, and less pain, are known. This reasoning is inconsistent with the Supreme Court's *KSR* decision and the U.S. Patent & Trademark Office's Examination Guidelines for Determining Obviousness under 35 U.S.C. 103.

For these reasons, the Office Action has failed to set forth a *prima facie* case of obviousness of claims 37 and 47.

Moreover, Applicants submit that no rationale as to why it would have been obvious for one of ordinary skill in the art to combine the purported teachings of Pagliuca and Chin in the manner set forth in the Office Action exists. One of ordinary skill in the art would recognize that Pagliuca teaches minimally invasive surgical procedures through a single incision using an expandable access device that allows visualization of the entire surgical area to be treated, e.g., one side of multiple vertebra, with an endoscope or other visualization device and procedures to be completed on the vertebra, such as instrumentation of one side of the vertebra. One of ordinary skill in the art would recognize that Chin teaches the advantages of separate percutaneous incisions to access each vertebra to be instrumented, *in contrast to using the type of expandable access devices and methods disclosed in Pagliuca.*

"The invention also provides the ability to sequentially connect a fixation device percutaneously between more than two points simultaneously and only directly visualizing the fixation points and not the entire connecting device. This scalable feature is currently a major limitation of other minimally invasive devices." Chin at paragraph 15.

Thus, Chin specifically teaches away from combining the teachings of Pagliuca and Chin.

For at least these reasons, Applicant requests withdrawal of the rejection of independent claims 37 and 47, and claims 38-46 dependent thereon, under 35 U.S.C. § 103(a).

***Conclusion***

In view of the remarks set forth above, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If there are any remaining issues or the Examiner believes that a telephone conversation with the Applicant's attorney would be helpful in expediting the prosecution of the application, the Examiner is invited to call the undersigned at (508) 880-8488.

Respectfully submitted,

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Date: February 4, 2009